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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,535	12/04/2000	Kiyomi Nakamura	503.39364X00	4344

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EXAMINER

IP, SIKYIN

ART UNIT	PAPER NUMBER
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1742

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14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7/10/02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-24, 26-32 is/are pending in the application.
- Of the above claim(s) 12-21 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-11, 22-24, 26, 27, 31, 32 is/are rejected.
- ☒ Claim(s) 28-30 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 4-11, 22-24, 27, and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 2000115 to ~~Wood~~ (claims 1-2), DE 1301914, NO 20675, or USP 4332864 to ~~King et al.~~ (abstract) in view of acknowledged prior art admission from page 1, line 11 to page 3, line 15 of the instant specification.

4. Claims 1-2, 4-11, 22-24, 26-27, and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over DE 1259578 (abstract) in view of acknowledged prior art admission from page 1, line 11 to page 3, line 15 of the instant specification.

5. Claims 1, 3-11, 22-24, 26-27, and 31-32 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 5964965 to Schulz et al (abstract) in view of

acknowledged prior art admission from page 1, line 11 to page 3, line 15 of the instant specification.

6. Claims 6, 7, 10, 23, 27, and 31 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4675157 to Das et al (Table 1, sample 5) in view of acknowledged prior art admission from page 1, line 11 to page 3, line 15 of the instant specification.

7. The cited reference(s) disclose(s) the features including the claimed Mg based alloy compositions. The features relied upon described above can be found in the reference(s) at: their abstracts. The difference between the reference(s) and the claims are as follows: Some cited references may have elements just outside the claimed range, do not disclose the claimed grain size, and/or do not disclose the claimed properties. However, it is well settled that a prima facie case of obviousness would exist where the claimed ranges and prior art do not overlap but are close enough that one skilled in the art would have expected them to have the same properties, *In re Titanium Metals Corporation of America v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *In re Woodruff*, 16 USPQ 2d 1934, and *In re Aller*, 105 USPQ 233.

8. The Mg based alloys of cited references may cast by different methods. But, acknowledged prior art admission in page 1, line 11 to page 3, line 15 discloses cast

Mg based alloy by die casting or injection molding are conventionally done in the art of cited references. It has been held a use of new material (here conventional Mg based alloy) in old process is not invention since process is merely being used with analogous material in same art for which process was developed, In re LaVerne, et al., 108 USPQ 335.

9. Furthermore, the invention defined in a product-by-process claim is a product, not a process. In re Bridgeford, 357 F. 2d 679, 149 USPQ 55 (CCPA 1966). It is the patentability of the product claimed and not of the recited process steps which must be established. See In re Brown, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972) and In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). The guidance that has been provided by court on this matter is

[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

In re Thorpe, 777 F.2d 695, 227 USPQ 964, 966 (Fed. Cir. 1985).

10. The limitation as set forth in claim 27 reads on solidification of the Mg alloy during casting which contains mixture of solid and liquid phases.

11. Moreover, the instant Mg based alloy compositions are overlapped by the cited references; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited references. Therefore, the burden is

on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Spade, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

In re Best, 195 USPQ, 430 and MPEP 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977).” see MPEP §2112.01

Allowable Subject Matter

12. Claims 28-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter: The claimed oxide film is not disclosed, taught, or suggested by references of record.

Response to Arguments

14. Applicant's arguments filed July 10, 2002 have been fully considered but they

are not persuasive.

15. Applicants argue that claimed tensile properties and grain size are not disclosed by cited references. But claimed properties are alloy material properties which would have been inherently possessed by the Mg based alloys of cited references. The burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product.

In re Best, 195 USPQ, 430 and MPEP § 2112.01.

“Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). ‘When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.’ *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977).”

16. Applicants argue that Figure filed on January 28, 2002 shows that claimed Al content and Sn content have improved the tensile and molten-flow performance respectively. But, said figure fails to show the claimed Al and/or Sn content is critical because comparison must be done under identical condition except for the novel features of the invention. *In re Brown*, 173 USPQ 685 and *In re Chapman*, 148 USPQ 711. The showing of unexpected results must be occurred over the entire

claimed range. In re Clemens, 622 F.2d 1029, 206 USPQ 289, 296 (CCPA 1980). The scope of the showing must be commensurate with the scope of the claims. In re Tiffin, 448 F.2d 791, 792 (Fed. Cir. 1971), In re Coleman, 205 USPQ 1172, and In re Greenfield, 197 USPQ 227.

17. Applicants argue that Mg based alloys of cited references are not and would not be die cast or injection molded. But, the acknowledged prior art admission in page 1, line 11 to page 3, line 15 of the instant specification discloses that the claimed cast methods are conventionally used for Mg based alloys. Accordingly, it would have been prima facie obvious for an ordinary skill artisan motivated by a reasonable expectation of success to use the for in order to obtain all of the known benefits. In re Venner, 120 USPQ 193 (CCPA 1958), In re LaVerne, et al., 108 USPQ 335, and In re Aller, et al., 105 USPQ 233. It has been held a use of new (here old) material in old patented process is not invention since process is merely being used with analogous material in same art for which process was developed, In re LaVerne, et al., 108 USPQ 335, and it has been held that discovery of an optimum value for a known process is an obvious engineering. In re Aller, 105 USPQ 233 (CCPA 1955).

18. Applicants argue that Mg based alloy of DE 1301914 contains additional alloying elements. But, the instant transitional expression "contains" which is

inclusive and fails to exclude unrecited ingredients even in major amounts. See Ex parte Davis et al. (POBA 1948) 80 USPQ 448 and In re Bertsch 132 F2d 1014, 56 USPQ 379 (CCPA 1942).

19. Applicants' argument in paragraph bridging pages 13-14 of the instant remarks is noted. But, the criticality of the claimed composition range has not been established. See item 16 above.

Conclusion

20. The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been met by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's

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supervisor, Dr. Roy V. King, can be reached on (703)-308-1146.

The facsimile phone number for this Art Unit 1742 are (703) 305-3601 (Official Paper only) and (703) 305-7719 (Unofficial Paper only). When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.



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PRIMARY EXAMINER
ART UNIT 1742

S. Ip
October 21, 2002